

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

MAR 29 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW KERR

Appeal No. 2006-0311
Application No. 09/900,241

HEARD FEBRUARY 22, 2006

Before FRANKFORT, CRAWFORD, and BAHR, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 3 and 25, which are all of the claims pending in this application. Claims 1, 2, 4 to 24, 26 and 27 have been canceled.

The appellant's invention relates to a stent and graft assembly for treating vascular anomalies (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Anderson et al. (Anderson) 5,800,526 Sep. 01, 1998

The rejection

Claims 3 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Anderson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (mailed July 1, 2005) and the final rejection (mailed December 28, 2004) for the examiner's complete reasoning in support of the rejection, and to the brief (filed April 14, 2005) and reply brief (filed July 27, 2005) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The examiner has rejected the claims under 35 U.S.C. § 102(b) as being anticipated by Anderson. We initially note that to support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The examiner's findings regarding the Anderson reference can be found on pages 3 and 4 of the answer.

The appellant argues that Anderson does not disclose:

... said first axial end of the graft means being fixedly connected with . . . stent means for achieving an end-to-end connection without overlap. . . whereby the end-to-end connection without overlap enables a smaller cross-section than a connection with overlap so that the endovascular stent/graft assembly can be introduced more easily into the blood vessel

as required by claim 25.

The examiner relies on column 11, lines 10 to 14 of Anderson which states:

Alternatively, the stent might be sewn onto the graft at selected points. At least a portion of stents **56,58** extend out of graft **52**, and if the stents and graft are joined by a butt joint, then substantially all of the stent will extend out of the graft.

In the examiner's view, the above-referenced disclosure of a butt joint is a description of an end-to-end connection without overlap between the stent and graft as required by claim 25.

We do not agree with the examiner. Firstly, as Anderson clearly discloses that substantially all of the stent extends out of the graft, Anderson implies that the connection is not without some overlap. In addition, while the examiner is correct that one of the definitions of a butt joint is a joint made by fastening the parts together end-to-end without overlap, there are other definitions for the term butt joint that would include a joint that has overlapping connections.

The appellant has filed a declaration, executed by the inventor Dr. Andrew Kerr, which is dated June 19, 2004 and filed on June, 24, 2004. In the declaration, Dr. Kerr states that he did not find any definition for the term "butt joint" in the literature relating to endovascular stent/graft assemblies. In addition, the declaration states that the term "butt joint" in the dentistry field would include a joint with overlapping parts.

This record also includes a copy of a chapter entitled "Butt Joint" from a book entitled "The Complete Illustrated Guide to Joinery" by Gary Rogowski in which a "butt joint" is described in the carpentry art to indicate a right angle joint.

In our view, as there are various definitions for the term "butt joint" and Anderson discloses that the stent overlaps the graft to at least some extent, the finding of the examiner that Anderson describes an end-to-end connection without overlap between the stent and graft is speculative at best and therefore the examiner has not established a prima facie case of anticipation. As such, we will not sustain the rejection of claim 25 and claim 3 dependent thereon.¹

To summarize, the decision of the examiner to reject claims under 35 U.S.C. § 102 is reversed.

REVERSED

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge

~~MURRIEL E. CRAWFORD~~
Administrative Patent Judge

~~MARY E. GAWRON~~
Administrative Patent Judge

Jennifer D. Bahr
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

¹ Upon return of this case, the examiner should consider whether a rejection under 35 U.S.C. § 103 of the claims on appeal should be made over Anderson and whether there is prior art in the tubular conduit art which more clearly defines the term "butt joint."

Appeal No. 2006-0311
Application No. 09/900,241

Page 6

CASELLA & HESPOS
274 MADISON AVENUE
NEW YORK, NY 10016

MEC/vsh